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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202718
Party	Plaintiff John Crane Production Solutions Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JOHN CRANE PRODUCTION SOLUTIONS INC., Opposer v. R2 R&D, LLC, Applicant.	Opposition No.: 91202718 Mark: FINALROD Serial No.: 76707726 Filed: May 24, 2011
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**REPLY IN FURTHER SUPPORT OF OPPOSER'S
MOTION TO SUSPEND PROCEEDINGS PENDING
FINAL DISPOSITION OF CIVIL ACTION**

Opposer John Crane Production Solutions, Inc. ("Opposer") respectfully submits this reply brief in support of its Motion to Suspend.

I. Relevant Background

On November 22, 2011, Opposer timely filed a Notice of Opposition against Intent-to-Use Application Serial No. 76707726 for the mark FINALROD for "machine and machine tools, namely, fiberglass sucker rods and fiberglass suck [sic] rod end-fittings" in International Class 7.

As grounds for the opposition, Opposer alleged, among other things, that Applicant's FINALROD mark was likely to cause confusion with Opposer's previously registered FIBEROD mark for the identical goods.

On November 22, 2011, Opposer filed a Complaint with District Court for the Northern District of Texas, Dallas Division, styled John Crane Production Solutions Inc.

v. R2R and D, LLC, Finalrod, Inc., and Russell P. Rutledge, and assigned Civil Action No. 3:11cv-3237-D. Opposer initially withheld service of the complaint pending attempts to engage in mediation with the defendants. When those efforts failed, the action was formally initiated.

Opposer's Complaint involves claims of trademark infringement, unfair competition, and common law trademark infringement.

On January 7, 2012, Applicant filed its Answer in the Opposition proceeding.

On January 10, 2012, Opposer filed a motion to suspend all proceedings pending disposition of the civil action.

On January 25, 2012, Applicant filed a brief in response to Opposer's motion to suspend, objecting to the suspension of the proceedings. Applicant argues against suspension of this action on two grounds. First, Applicant contends that the Motion to Suspend was filed by a non-party and therefore fails to satisfy the requirements of 37 C.F.R. Section 2.117(c). Second, while conceding that the pending federal court action concentrates on the issue of likelihood of confusion between the very same marks at issue in this Opposition, Applicant argues that the Board, and not the U.S. District Court for the Northern District of Texas, is best qualified to determine the issue of likelihood of confusion. Applicant further contends that the Motion to Suspend should be denied to penalize Opposer for initiating two separate actions. For the reasons set forth below, however, Applicant's arguments have no merit.

II. Argument

A. Opposer's Motion Complies with the Trademark Rules

In its opposition to Opposer's Motion to Suspend, Applicant argues that an inadvertent typographical error in the top line of Opposer's signature block should defeat an otherwise valid and properly filed Motion to Suspend. Applicant's argument is without merit.

Opposer's Motion to Suspend was properly captioned and signed by counsel of record for Opposer. Opposer's Motion properly identified the Opposition number, the named parties, and the legal basis for its Request to Suspend. The signature line clearly provided that signing counsel was appearing on behalf of Opposer. The mere presence of an inadvertent clerical error in the top line of Opposer's signature block should not be permitted to defeat an otherwise clear and meritorious motion.

B. Suspension of Proceedings Will Preserve the Board's Limited Resources and Should Be Granted

Under Trademark Rule 2.117(a), when the parties to a Board case are involved in a civil action that may be dispositive of or have a bearing on the Board case, the case may be suspended pending a final determination of the civil action. See TBMP § 510.02(a). The Board has repeatedly held that suspension of a Board case is appropriate even if the civil action may *not* be dispositive of the Board case, so long as the ruling will have a *bearing* on the rights of the parties in the Board case. See *e.g.*, *Martin Beverage Co. Inc. v. Colita Beverage Co.*, 169 USPQ 568, 570 (TTAB 1971).

In this case, both Opposer and Applicant are parties to the civil action that would be entirely dispositive of this Opposition proceeding. In particular, and as noted in

Opposer's original Motion, Opposer is currently pursuing a civil action against applicant and others asserting claims of, *inter alia*, trademark infringement, false designation of origin, passing off, and unfair competition against very same trademark and goods that are the subject of this opposition proceeding. Applicant acknowledges this overlap repeatedly in its brief in response to the Motion. Nevertheless, it requests that the Board penalize Opposer for initiating two separate actions by forcing Opposer to pursue both overlapping actions simultaneously.

Contrary to Applicant's contention, a decision of the Federal district court concerning the above issues will be binding upon this Board, whereas a decision of the Board is not binding on the court. *Goya Foods, Inc. v. Tropicana Products, Inc., v. Tropicana Products, Inc.*, 6 USPQ 2d 1950 (2d Cir. 1988). Whatever the Board were to decide in this proceeding could be rendered moot upon the Federal District Court's determination of the issues in the civil action. Judicial economy, fairness, and simple common sense compel that this proceeding be suspended pending disposition of the civil action. *See Mother's Restaurant, Inc. v. Mama's Pizza, Inc.*, 221 USPQ 392 (Fed. Cir. 1983) (discussing the preclusive effect of court rulings on the Board). The suspension of this case will enable both the Board and the parties to avoid the unnecessary duplicative expense of litigating the common issues in two proceedings.

Applicant complains of having been forced to file responses in both the civil action and this Opposition. Yet, as a remedy, it seeks to force both parties and this tribunal to waste time and resources pursuing duplicative actions to their conclusion. The absurdity of Applicant's position is clear on its face.

III. Conclusion

Accordingly, Opposer respectfully reiterates its request that the Board suspend all proceedings pending final disposition of the civil action.

Respectfully submitted,

Dated: January 30, 2012

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER'S REPLY IN FURTHER SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS PENDING FINAL DISPOSITION OF CIVIL ACTION was served by first class mail, postage prepaid, on this 30th day of January 2012, upon counsel for Applicant at the following addresses of record:

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